

## **REMARKS**

Reconsideration is respectfully requested.

Claims 1-41 are cancelled. Claims 42-51 are added. Claims 42-51 are pending. Support for the amendments is found in the specification and originally filed claims.

With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

### **Interview Summary**

Applicants thank the Examiner for the courtesy of the personal interview at the Patent Office on September 12, 2006.

With respect to the issue of utility, after discussing the nature of the invention it was agreed that amending the claims to recite screening of designed polypeptides for desired properties would facilitate resolution of the issue of utility. With respect to the art rejection, Applicant emphasized the difference between the method of the invention and the Topham reference and maintained that Topham should not be grounds for rejection of the present invention.

### **Rejection under 35 USC §112, second paragraph**

Claims 33-41 are rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants have cancelled claims 33-41, rendering this rejection moot. Applicants believe new claims 42-51 are definite, and that the application is now in condition for allowance.

### **Rejections under 35 U.S.C. §§ 101/112**

Claims 33-41 are rejected under 35 U.S.C. §§ 101/112 for lacking a specific asserted utility or a well established utility. Applicants have cancelled claims 33-41, rendering this rejection moot. In light of the interview summary above and new claims 42-51, Applicants believe that the application is now in condition for allowance.

### **Rejections under 35 U.S.C. § 112, first paragraph**

Claims 33-40 are rejected under 35 U.S.C. 112, first paragraph. For the reasons set forth above, Applicants respectfully submit that the claimed invention has a specific asserted

utility, and one of skill in the art would understand how to use the claimed invention. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

### Rejections under 35 U.S.C. §§ 102 and 103

Claims 33-40 are rejected under 35 U.S.C. § 103(a) as being obvious over Topham et al. Applicants assume that the Office Action refers to Topham et al., *J. Mol. Biol.* (1993) **229**, 194-220. As stated in previous replies, Applicants respectfully maintain that several of the limitations of the present invention are neither taught or suggested by Topham, and thus cannot be obvious in light of Topham. Additionally, new claims 42-51 require that a screened variant protein of the present invention is non-naturally occurring, a limitation not taught or suggested by Topham, as agreed in the interview of September 12, 2006.

Applicants respectfully request the rejection of the pending claims as obvious over Topham be withdrawn, and submit that claim 42-51 are in condition for allowance.

### Conclusion

Applicants respectfully assert that the present claims are in condition for immediate allowance. If an interview would expedite prosecution of the present application, the Examiner is invited to contact the undersigned at (415) 781-1989.

Respectfully submitted,  
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